REMARKS

This is in full and timely response to the non-final Office Action dated March 15, 2005 (Paper No. 03042005). The present Amendment amends claims 14 and 19 to correct a minor matter of form and otherwise disputes certain findings of fact made in connection with the rejection of the claims. Support for these amendments can be found variously throughout the specification, including, for example, original claim 14. No new matter has been added. Accordingly, claims 7-19 are presently pending in the application, each of which is believed to be in condition for allowance. Reexamination and reconsideration in light of the present Amendment and the following remarks are respectfully requested.

Claim to Priority

Acknowledgement of the proper receipt of the certified formal papers filed in connection with Applicant's claim to priority under 35 U.S.C. § 119(a)-(d) is noted with appreciation.

Drawings:

Acceptance and entry of the amended Drawings filed January 23, 2004 is noted with appreciation.

Claim Rejections- 35 U.S.C. § 102

In the Action, claims 7-10 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,948,549 to Takayama et al. ("Takayama '549"). This rejection is respectfully traversed.

Independent claim 7 of the present application recites a copper based sintered contact material, wherein, *inter alia*, **the total amount of intermetallic compounds is 0.1 to 10% by volume**.

In contrast, Takayama '549 fails to disclose, teach or suggest the total amount of intermetallics compounds being equal to 0.1 to 10% by volume, as is recited in claim 7 of the present application. In fact, the Action has **conceded** that "Takayama '549 is silent as to the volume % of intermetallics in the contact", thereby rendering the § 102 rejection of claim 7 ineffective. *See* pg. 5 of Action.

Accordingly, because Takayama '549 de facto fails to disclose, teach or suggest each and every limitation of claim 7, a *prima facie* anticipation rejection has not been established, and withdrawal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference").

Moreover, aside from the novel limitations recited therein, claims 8-10 and 12, being dependent either directly or indirectly upon allowable base claim 7, are also allowable at least by virtue of their dependency upon allowable claim 7. Withdrawal of the rejection of these claims is therefore courteously solicited.

Claim Rejections- 35 U.S.C. § 103

In the Action, claims 7-10 and 12-19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takayama '549 in view of U.S. Patent No. 6,613,121 to Takayama et al. ("Takayama '121"). The Takayama '121 reference is, however, not prior art with respect to the present application.

Since the present application is a divisional application of U.S. Patent No. 6,844,085, which was filed in the USPTO on July 12, 2002, the present application claims the benefit of the filing date of the 6,844,085 patent. In addition, because the Takayama '121 reference was filed less than one year prior to the filing date, Takayama '121 may only qualify as prior art under § 102(e)/103. Under 35 U.S.C. § 103(a) as amended in the American Inventors Protection Act of November 29, 1999, and 37 C.F.R. § 1.104(c)(4), a patent cannot be used as basis for a § 102(e)/103 rejection if two requirements are met. First, the cited patent and the present application must be assigned to a common owner in assignments that are recorded with the U.S. Patent and Trademark Office. Second, the owner or the owner's legal representative must assert that at the time the invention claimed in the patent application was invented, the invention was assigned to the same assignee that owns the patent.

The Takayama '121 patent is assigned to Komatsu, Ltd. of Japan ("Komatsu") and was so assigned when the present application was filed. In addition, at the time the invention was made, the current inventors were under obligation to assign the invention to Komatsu, and did in fact assign the invention to Komatsu by way of the assignment recorded July 12, 2002 on Reel

013104, Frame 0786 in the parent application (U.S. Patent No. 6,844,085). Consequently, the Takayama '121 patent is not prior art with respect to the present invention under 35 U.S.C. § 103(a). Accordingly, because Takayama '549 concededly fails to teach each of the limitations recited in claim 7 of the present invention, and further because Takayama '121 is not prior art under 35 U.S.C. § 103(a), a *prima facie* obviousness rejection of claim 7 has not been established, and withdrawal thereof is respectfully requested.

Moreover, aside from the novel limitations recited therein, claims 8-19, being dependent either directly or indirectly upon allowable base claim 7, are also allowable at least by virtue of their dependency upon allowable claim 7. Withdrawal of the rejection of these claims is therefore courteously solicited.

Conclusion

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. KOM-0153/INO/DIV3, from which the undersigned is authorized to draw.

Dated: May 27, 2005

Respectfully submitted,

By_____

Ronald P. Kananen
Registration No.: 24,104
RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W.
Suite 501
Washington, DC 20036
(202) 955-3750
Attorney for Applicant